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REMARKS

In the outstanding Office Action, the Examiner has rejected Claims 23-44. Claims 23 and 35 have been amended, no new matter has been added. Thus, Claims 23-44 are presented for further examination. Reconsideration and allowance of all Claims 23-44 in light of the present remarks is respectfully requested. As discussed with the Examiner on July 30, 2003, Claim 23 is amended to remove a surplusage prepositional phrase. In addition, Claim 35 is amended to correct a capitalization error and a typographical error. These amendments are not being made for patentability and do not narrow the scope of protection.

Discussion of Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 38, and 43 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,964,156 to Blair. The Examiner has also rejected Claim 44 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,682,351 to Makino.

Claim 38

In regard to Claim 38, the Examiner stated that "Blair discloses a cellular telephone unit capable of automatic interaction with audio services (column 1, lines 10-15), (which reads on claimed "a method of providing a mailbox answerphone service") (column 1, line 14 "voice mailbox systems") ... wherein the answerphone service identifies a mailbox associated with a subscriber by way of an identification code". The Examiner also stated that Blair discloses "receiving a call (column 5, line 55 "a call") from a mobile handset (10 on FIG.1), the call being directed to a directory number (column 5, lines 57-58 "the telephone number") used commonly by different subscribers to access their mailboxes (column 5, lines 54-63)", wherein "the logic circuitry of the mobile unit retrieves the telephone number of the voice mailbox system to be dialed".

Further with respect to Claim 38, the Examiner asserted that Blair discloses "allowing the caller to input a selection indicator (column 6, line 1 "DTMF transmission of a number") during the call (column 6, lines 1-9)", wherein "the logic circuitry makes a DTMF transmission of a number corresponding to the password". The Examiner also asserted that Blair discloses, "if the indicator is not received, detecting a first identification code (column 7, line 13 "a first pause command") associated with the mobile handset from information received during call

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establishment (column 7, line 22 “800-555-1212””, wherein “the first identification to identify the desired mailbox to retrieve the messages is transmitted by the logic circuitry”; and if the indicator is received, “allowing the user to input a second identification code (column 8, line 11 “additional password”) and providing a message retrieve service (310 on FIG. 3) to allow the caller to retrieve messages from the mailbox associated with the second identification code (column 8, lines 11-38)”, where “the user enters a key stroke sequence for a second password in [order] to retrieve the messages”.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

Claim 38 recites a method of providing a mailbox answerphone service to a caller in a mobile communications system, wherein the answerphone service identifies a mailbox associated with a subscriber by way of an identification code. The method comprises “receiving a call from a mobile handset, the call being directed to a directory number used commonly by different subscribers to access their mailboxes; allowing said caller to input a selection indicator during the call; and (a) if said indicator is not received, detecting a first identification code associated with said mobile handset from information received during call establishment and providing a message retrieve service to allow the caller to retrieve messages from the mailbox associated with said first identification code; or (b) if said indicator is received, allowing the user to input a second identification code and providing a message retrieve service to allow the caller to retrieve messages from the mailbox associated with said second identification code.”

Blair describes a cellular telephone unit including logic circuitry programmed to automatically initiate a check of a voice mailbox system. In one embodiment, the logic circuitry waits a specified pause time, then makes a DTMF transmission of a number corresponding to the password that identifies a particular voice mailbox. *Blair, col. 5, line 54 through col. 6, line 9*. In another embodiment, user memory locations can be loaded with the telephone number or access number of the voice mailbox system, pause commands, and a password. *Col. 6, lines 60-66*. In an additional embodiment, the voice mailbox system requires two transmissions of the password where the first transmission identifies the mailbox and the second transmission authenticates the caller’s access authority. *Col. 7, line 55 through col. 8, line 38*.

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Applicant respectfully disagrees with the Examiner's characterization of Blair, and respectfully submits that the "logic circuitry ... mak[ing] a DTMF transmission of a number corresponding to the password" (Blair, col. 5, ll. 67-68-col. 6, l. 2) in no way anticipates or describes "allowing [a] caller to input a selection indicator during the call" as recited in Claim 38. Specifically, the logic circuitry DTMF transmission in Blair is not in response to input of a selection indicator (such as the "star" key as disclosed in Applicant's specification with reference to one embodiment of the invention) by a caller.

In addition, the Examiner identifies "a first pause command" as corresponding to "a first identification code" as recited in Claim 38. However, there is no mailbox associated with this pause command, whereas Claim 38 recites "providing a message retrieve service to allow the caller to retrieve messages from the mailbox associated with said first identification code".

Furthermore, with respect to the second identification code recited in Claim 38, in the embodiment in Blair requiring two transmissions of the password, the second password is the same as the first, and therefore the mailbox associated with the second password is the same as the mailbox associated with the first password. Thus, Blair fails to teach a "first identification code" and a "second identification code" as recited in Claim 38.

Therefore, as Blair fails to describe, either expressly or inherently, every element as recited in Claim 38, Applicant respectfully submits that Claim 38 is in condition for allowance.

Because Claims 39-41 depend from Claim 38, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

Claim 43

In regard to Claim 43, the Examiner stated that "Blair discloses a cellular telephone unit ... wherein the apparatus is adapted to identify a first subscriber making a call to retrieve a message by means of an identification signal (column 7, line 13 "a first pause command") automatically forwarded to the apparatus during call establishment (column 7, line 13 "in a dialing sequence"), the signal identifying the equipment being used by the subscriber (column 7, lines 12-42)", where "the first identification to identify the desired mailbox to retrieve the message is transmitted by the logic circuitry". (Irrelevant citations omitted)

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The Examiner also stated that Blair's "apparatus is further adapted to identify a second subscriber (column 7, line 60 "the caller's access authority"), on receipt of a request (column 7, line 57 "gain access") from the second subscriber during the call, by way of other information (column 7, line 62 "additional password") supplied by the second subscriber during the call (column 7, lines 55-62)", where "the user can access the voice-mailbox system using a second password to retrieve his messages".

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

The apparatus of Claim 43 is "adapted to store messages for subsequent retrieval by a subscriber of the mobile communications system wherein said apparatus is adapted to identify a first subscriber making a call to retrieve a message by means of an identification signal automatically forwarded to said apparatus during call establishment, said signal identifying the equipment being used by said subscriber, and wherein said apparatus is further adapted to identify a second subscriber, on receipt of a request from said second subscriber during the call, by way of other information supplied by said second subscriber during the call."

Blair fails to teach that the "identification signal automatically forwarded" to the voice mailbox system identifies the "equipment being used by the subscriber," as recited in Claim 43. Applicant respectfully disagrees with the Examiner's characterization of Blair, wherein neither "a first pause command" nor "the first identification to identify the desired mailbox ... transmitted by the logic circuitry" identify the equipment being used by the subscriber.

Furthermore, Blair fails to teach identifying a second subscriber on receipt of a request from the second subscriber during the call. In regard to Blair's two password embodiment, correct entry of the second password would still identify the first subscriber and not a second subscriber.

Thus, as Blair fails to describe, either expressly or inherently, every element of Claim 43, Applicant respectfully submits that Claim 43 is in condition for allowance.

Claim 44

In regard to Claim 44, the Examiner stated that "Makino discloses a cordless telephone system (which reads on claimed "an apparatus for use in a mobile communications system"), ...

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the apparatus being responsive during the call to receipt of a response selection indicator, ... wherein the apparatus is arranged to select one of the mobile subscribers (“to confirm the station”) and/or to select one of a plurality of predetermined responses (“dial signal) if the response selection indicator is received, and otherwise to automatically provide a particular response (“the function”) relating to one of the mobile subscribers”, where “the mobile station upon the detection of off-hook signal transmits a call origination signal to the base station and depending of the ID codes a different function”. (Citations omitted)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

The apparatus of Claim 44 is “responsive during the call to receipt of a response selection indicator, and to receipt of a number of identification codes each being associated with a different mobile subscriber, wherein said apparatus is arranged to select one of said mobile subscribers and/or to select one of a plurality of predetermined responses if said response selection indicator is received, and otherwise to automatically provide a particular response relating to one of said mobile subscribers.”

Makino describes a cordless telephone system wherein a plurality of mobile stations are connectable to a single base station via a radio link. Each of the mobile stations is provided with an identification code which is different from identification codes assigned to the other mobile stations, wherein the identification codes are indicative of a master-slave relationship and a priority order between the mobile stations. A mobile station T1 transmits a call origination signal to the base station in response to detection of an off-hook condition. The base station detects the ID code out of the call origination signal to confirm that station T1 is the associated master station. The base station then activates the radio link and connects the station T1 to the subscriber’s line. When a slave mobile station T2 originates a call, the base station inhibits the delivery of dial signals.

Makino, however, fails to describe that the cordless telephone system is “responsive during the call to receipt of a response selection indicator” as recited in Claim 44, nor does the Examiner point to any teaching of such a function in Makino.

In addition, the identification codes in Makino are assigned to each mobile station or handset, wherein the identification codes are used to determine whether each mobile station is a

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master mobile station or a slave mobile station. In contrast, in the apparatus of Claim 44, each identification code is associated with a different "mobile subscriber". Specifically, in Makino's cordless telephone system there is only one subscriber line for the plurality of mobile stations.

Thus, as Makino fails to describe, either expressly or inherently, every element as recited in Claim 44, Applicant respectfully submits that Claim 44 is in condition for allowance.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 23-27, 31-37, and 42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,987,317 to Venturini in view of U.S. Patent No. 5,838,772 to Wilson, et al. In addition, Claims 39 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Blair in view of U.S. Patent No. 5,889,839 to Beyda, et al., and Claim 41 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Blair in view of U.S. Patent No. 5,497,373 to Hulen.

In regard to Claim 23, the Examiner stated that "Venturini discloses an automatic system message waiting indicator, (which reads on claimed "a method of providing a mailbox answerphone service), ... comprising: providing an identification code ("the access code") identifying a mailbox ("mailbox") associated with a subscriber ("user") through an identification code ("the access code") through an answerphone service", where "the mobile terminal dials the access code with a request to retrieve the voice messages from the voice mailbox". (citations omitted) The Examiner also asserted that Venturini discloses "entering either a first mode of answerphone operation (column 8, line 52 "a MWI message") or a second, different, mode of answerphone operation (column 8, line 66 "networks") in dependence on information (column 8, line 60 "NRI information") received during call establishment (column 8, lines 49-67)", where "in response to the mobile terminal NRI information a message may be provided from one of the networks".

The Examiner recognizes that "Venturini fails to disclose the call is of international origin." However, the Examiner stated that "Wilson teaches the call is of international origin (column 8, lines 31-38)", and that "it would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the call is of international origin of Wilson in the invention of Venturini."

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To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art references, when combined, must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Claim 23 recites a method of providing a mailbox answerphone service to a caller in a mobile communications system during a call directed to a directory number used commonly by different subscribers to access their mailboxes. The method comprises “providing an identification code identifying a mailbox associated with a subscriber through an answerphone service; and entering either a first mode of answerphone operation or a second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin.”

In Venturini, in response to the user depressing a softkey, the mobile terminal examines the network registration indicator (NRI) information stored in memory to determine the network with which the mobile terminal is registered. The mobile terminal then dials the access code for the voice mailbox of this network to request retrieval of the voice messages stored in the voice mailbox. *Venturini, col. 8, lines 57-64.*

It is unclear as to what the Examiner is referring to as disclosing “a first mode of answerphone operation” and “a second, different mode of answerphone operation” as recited in Claim 23. However, in the cited passage, Venturini teaches that a different access code is required for different networks with which the mobile terminal might be registered. *Venturini, col. 8, lines 57-64.* Applicant respectfully submits that dialing a first access code and dialing a second access code cannot properly be construed as “a first mode of answerphone operation” and “a second, different mode of answerphone operation”. Venturini fails to teach operational mode changes in the answerphone due to a change in the network the mobile terminal is currently registered with. Venturini discusses how the message waiting indicator (MWI) is provided to the handset (col. 8, line 65 - col. 9, line 13), but this has nothing to do with a mode of operation such as how messages are retrieved.

Furthermore, dialing a first access code or a second access code is not “in dependence on information received during call establishment” as recited in Claim 23, as the NRI information is already stored in memory at the mobile terminal prior to call establishment. *Col. 8, lines 25-27.*

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Wilson discloses a voice services equipment that can be used, among other services, for international account calls. *Col. 8, line 31.* Wilson only describes providing different information according to the country of origin of the call. For example, audio information for the originating country could be provided. *Id.* However, Wilson does not teach or suggest entering a different mode of answerphone operation based on whether the call is of international origin. Furthermore, it is not clear how Venturini would be modified to include the teachings of Wilson, nor is there any teaching or suggestion to do so in either Venturini or Wilson.

Moreover, in the event Venturini were modified with the teachings of Wilson as suggested by the Examiner, the modified mobile terminal would still fail to enter a first mode of answerphone operation or a second, different mode of answerphone operation in dependence on whether the call is of international origin.

Thus, as neither Venturini nor Wilson, either alone or in combination, teach or suggest every element as recited in Claim 23, Applicant respectfully submits that Claim 23 is in condition for allowance. The arguments with respect to Claim 23 similarly apply to Claims 35 and 42, therefore, Claims 35 and 42 are respectfully submitted for further review as patentable subject matter.

Because Claims 24-34 and 36-37 depend from Claims 23, 35, and 42, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above. In light of these remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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